

## REMARKS/ARGUMENTS

Claims 44-47 and 50 remain pending in this application. Claims 48, 49 and 51 have been canceled. Claims 44-47 and 50 have been amended to more clearly define the invention. In particular, claim 44 has been amended to include some of the features found in claims 45, 50 and 51, as previously presented, as well as some additional features that may be found in the drawings and in the specification (see, for example, pg. 6, lines 11-19 and pg. 9, line 13 to pg. 11, line 4).

The Examiner has rejected claims 44-51 under 35 U.S.C. 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which application regards as the invention. As such, claim 44 has been amended to cure any deficiencies concerning the antecedent basis for the limitations in this claim.

Claims 44, 48 and 49 have been rejected under 35 U.S.C. 102(b) as being anticipated by GB 2 316 244 and Kikuchi et al. (US 5,250,786). Claims 45-47 have been rejected under 35 U.S.C. 103(a) as being unpatentable over GB 2 316 244 or Kikuchi et al. (US 5,250,786) in view of DE 26 50 522.

Applicants submit, however, that claim 44, as amended, is patentably distinguishable over the art of record.

Claim 44, as amended, covers an electric arc welding apparatus comprising a welding station, a battery for providing a DC battery voltage and a high switching speed converter. Further, the high switching speed converter includes a pulse width modulator that at least partially controls the signal conditioned for welding and waveform generator that at least partially controls the pulse width modulator. Thus, the high switching speed converter creates a series of current pulses that constitute a welding cycle representative of a current waveform and the pulse width modulator controls a current pulse width of a plurality of current pulses. In addition, the electric arc welding apparatus is movable on a wheeled carriage.

This approach, as presented in amended claim 44, differs from GB 2 316 244 and Kikuchi et al. (US 5,250,786) in at least two respects. For example, neither reference discloses an electric arc welding apparatus incorporating a high switching speed converter with the features noted above. Further, neither reference discloses that the electric arc welding apparatus is movable on a wheeled carriage. Moreover, the other references cited by the Examiner fail to overcome these deficiencies.

More particularly, the Examiner has asserted that it would have been obvious to combine certain aspects of DE 26 50 522 (rollable arc welding trolley for inert gas welding) and Baker (US 5,864,116) (DC chopper with inductance control for welding) to produce the claimed invention. However, the Examiner has provided no reference, or other evidence to support his conclusion that it would be obvious to one skilled in the art to modify the welders of GB 2 316 244 and Kikuchi with the teachings of DE 26 50 522 and Baker, aside from conclusory statements such as the ones found on page 5, last paragraph, and on page 6, last paragraph. Applicants assert that the Examiner has impermissibly concluded that claims 45-47 and 50-51, as previously presented, are obvious in view of a combination of GB 2 316 244 , Kikuchi, DE 26 50 522 and Baker without any legitimate support on the record and respectfully requests, in accordance with the obligations imposed under MPEP §2144.03 (should a rejection of amended claim 44 be maintained), that the Examiner provide one or more references or other suitable evidence showing that one skilled in the art would be motivated to modify the teachings of GB 2 316 244 or Kikuchi with the teachings of DE 26 50 522 and Baker.

As the Examiner is aware, a *prima facie* case of obviousness is not established absent proper motivation. Simply because certain teachings of DE 26 50 522 and Baker *could* be used in other welders, a motivation to modify GB 2 316 244 or Kikuchi to meet the limitations of claim 44, as amended, is not formed. Moreover, according to MPEP §2144.01, the “fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish *prima facie* obviousness.” Merely because the claimed elements are individually found in the prior art, it does not necessarily follow that it would be obvious to combine the elements from different prior art references. See MPEP §2141.01, citing *Ex Parte Levingood*, 28 USPQ2d 1300 (Bd. of Pat. App. & Int. 1993).

Consequently, absent a motivation to combine and modify GB 2 316 244 or Kikuchi with the teachings of DE 26 50 522 and Baker, it is irrelevant that the elements and/or limitations may be individually or separately known in the prior art. Clearly, the Examiner is motivated to combine these teachings for no other reason than to arrive at the claimed invention. This is a classic example of impermissible hindsight. Accordingly, claim 44, as amended, and claims 45-47 and 50, which depend therefrom, are patentably distinct over the references of record for the reasons discussed herein.

## CONCLUSION

For the reasons detailed above, it is respectfully submitted all claims remaining in the application (Claims 44-47 and 50) are now in condition for allowance.

Respectfully submitted,

FAY, SHARPE, FAGAN,  
MINNICH & McKEE, LLP

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7/25/06

Date

John S. Zanghi, Reg. No. 48,843  
1100 Superior Avenue, Seventh Floor  
Cleveland, OH 44114-2579  
216-861-5582

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